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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/472,988	12/28/1999	TERUAKI OKUDA	35.G2524	9448

5514 7590 05/21/2003

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NEW YORK, NY 10112

EXAMINER

SCHWARTZ, PAMELA R

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 05/21/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

09/472,988

Applicant(s)

OKUDA, TERUAKI

Examiner

Pamela R. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/28/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 4,5 and 7-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-11 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

1. This restriction is in addition to those set forth in prior Office Actions.

Newly submitted claims 10 and 11 are directed to an invention that is independent or distinct from the invention originally claimed and examined for the following reasons:

The inventions are distinct, each from the other because:

Inventions of Claims 1-3 and 6 and of Claims 10-11 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process such as the process of withdrawn claim 4.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 10-

11 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

It is noted that claims 4, 5, and 7-9 remain withdrawn from further consideration as drawn to a previously non-elected invention.

2. Claims 7-9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 15. The traversal is on the grounds that it would not require undue effort, would be efficient and would lead to greater uniformity of prosecution. The restriction is maintained based upon the reasons of record and because there would be a considerable additional search and examination burden were the claims to be handled together.

The restriction requirements of the earlier office actions are therefore made **final**.

3. The term “primarily comprises” is being interpreted for examination as “open” claim language without requiring any particular quantities or relationship of materials since there is no way of knowing in what sense the term “primarily” limits the claim or in what sense the latex is required to be

"primary" (by weight, by volume, by effect, etc) in the layer. The term does not appear to be defined in the specification and applicants cited support for the amendment is an example that uses 100% thermoplastic latex in the layer. Therefore, the layer could be described as any of comprising, consisting essentially of, or consisting of thermoplastic latex and the broadest possible interpretation will be adopted for the phrase.

4. Claims 1-3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over either one of Hirose et al. (6,203,899) taken alone or in view of either of Malhotra (6,180,238) or Cousin et al. (4,554,181) for reasons of record and for reasons given below.

5. Applicant's arguments filed February 28, 2003 have been fully considered but they are not persuasive. In particular, applicants argue that the surface layer of Hirose et al. would ^{not} inherently be transparent. The examiner disagrees. First, the surface layer of Hirose et al. may contain binder and ultrafine particles. The particles are 1 to 500 nm in diameter (see col. 3, lines 52-61). Second, the ratio of particles to binder is 50:1 to 1:2. Therefore, the layer may contain twice as much binder as pigment. Third, similar layers taught in the prior art are transparent. For example, in 6,214,458 to Kobayashi et al. a transparent layer (see col. 2, lines 33-35) is

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disclosed as containing agglomerated silica (primary particle size of less than 10 nm) of particle size between 10 and 100 nm, and has a ratio of silica to resin of from 1.5:1 to 10:1 (see col. 15, lines 34-54). This range overlaps considerably with that of Hirose et al. and demonstrates that transparent surface layers are inherently disclosed by Hirose et al.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

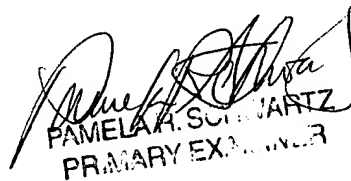
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela R. Schwartz whose

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telephone number is 703-308-2424. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on (703) 308-0449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

PRSchwartz
May 12, 2003



PAMELA H. SCHWARTZ
PRIMARY EXAMINER